

**BEST AVAILABLE COPY****REMARKS/ARGUMENTS****I. Introduction**

This response is submitted in response to the Office Action dated June 16, 2005. Applicants have canceled claims 1-5, 18-24 and 26-35 (without prejudice to re-presenting the subject matter of these claims at a later time) and amended claims 7, 9-12. Accordingly, claims 6-17 and 25 are now pending. No new matter has been introduced in any of the amendments.

The following claims have been rejected by the Examiner in the Office Action (as the rejections of canceled claims are now moot, canceled claims will not be discussed unless necessary to understand the rejection of pending claims):

- Claims 14-16, and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,732,151 to Tobias et al. (hereinafter "the Tobias patent"), combined with U.S. Patent Application Publication No. 2001/0043678 to Tverskoy et al. (hereinafter "the Tverskoy application"), in further view of U.S. Patent No. 6,295,341 to Muller (hereinafter "the Muller patent").
- Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the Tobias patent combined with the Muller patent in further view of the Tverskoy application.
- Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the Tobias patent combined with U.S. Patent No. 6,563,912 to Dorfman et al. (hereinafter "the Dorfman patent") in further view of U.S. Patent No. 4,757,525 to Matthews et al. (hereinafter "the Matthews patent").
- Claims 9-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Tobias patent in view of U.S. Patent No. 5,737,393 to Wolf (hereinafter "the Wolf patent").
- Claim 17 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the Tobias patent combined with the Tverskoy application and U.S. Patent No. 6,108,688 to Nielsen (hereinafter "the Nielsen patent") in further view of the Muller patent.

- Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the Tobias patent combined with the Dorfman patent and the Matthews patent, in further view of U.S. Patent No. 6,226,360 to Goldberg et al. (hereinafter “the Goldberg patent”).

Applicants respectfully traverse these rejections, in view of the above amendments and following remarks. It is respectfully submitted that all of the pending claims are patentable over the cited references.<sup>1</sup>

## II. Claims 14-16 and 25 are Patentable

Claim 14 recites a method that includes:

receiving an E-mail message indicating that a voice message retrieved from said voice message system and forwarded to a service subscriber was reviewed;  
in response to receiving said E-mail message, accessing said voice message system; and  
controlling said voice message system to delete said retrieved voice message.

In rejecting claim 14 relying on the Tobias patent as the primary reference, the Examiner admits that “the Tobias patent does not indicate the claimed receiving, accessing and controlling methods.” (Office Action, p. 6.) To overcome these admitted deficiencies of the description of the Tobias patent with respect to claim 14, the Examiner asserts that “Tverskoy shows the receiving method (paragraph 0033).” (Office Action, p. 6.) Applicants must disagree with this assertion, as the cited portion of the Tverskoy application merely describes sending “commands” by email to an answering machine. In fact, the Tverskoy application does not teach or suggest “receiving an E-mail message indicating that a voice message retrieved from said

<sup>1</sup> As Applicants’ remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicants’ silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

voice message system and forwarded to a service subscriber was reviewed," which is the element recited in claim 14.

The Examiner further admits that "the combination of Tobias and Tverskoy does not show the claimed accessing and controlling methods." (Office Action, p. 7.) To overcome these admitted deficiencies of both the Tobias patent and the Tverskoy application, the Examiner asserts that "Muller reveals these limitations (column 6)." (Office Action, p. 7.) Applicants must also disagree with this assertion, as the Muller patent (as was also the case for the Tverskoy application) offers no description of an e-mail that indicates that a voice mail message was received, or deleting a voice mail message in response to such email message, as recited in claim 14.

The absence of at least the elements of claim 14 noted above indicates that claim 14 is patentable over the Tobias patent, the Tverskoy application and/or the Muller patent (either alone or in combination). Therefore, Applicants respectfully request that the rejection of claim 14 be withdrawn. As claims 15 and 16 depend from claim 14, and therefore include all of the limitations of claim 14, these claims are patentable over the cited references for at least the same reasons as claim 14,<sup>2</sup> and therefore Applicants respectfully request that the Examiner withdraw the rejections of claims 15 and 16 as well.

Claim 25 recites a device that includes various means for performing the method steps recited in claim 14. As noted above for claim 14, since the cited references do not teach or suggest all of the means elements of claim 25, Applicants believe claim 25 to be patentable over the cited references for at least the same reasons as claim 14, and therefore respectfully requests that the Examiner withdraw the rejection of claim 25.

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<sup>2</sup> As Applicants' remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejections of all claims dependent therefrom, Applicants' silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicants to the Examiner's assertions as to these claims, and Applicants reserve the right to analyze and dispute such assertions in the future.

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**III. Claim 6 is Patentable**

Claim 6 recites a method that includes:

accessing a voice message system;  
retrieving, over a public telephone network, a voice message  
from the voice message system;  
generating a digital audio file representing said message;  
storing the retrieved voice message in a memory device from  
which the service subscriber can retrieve messages by telephone;  
sending, using at least one Internet Protocol (IP) packet, the  
digital audio file representing said message to a service subscriber;  
receiving a reply to said sending the digital audio file;  
deleting the retrieved message from said voice message system  
in response to receiving said reply; and  
in response to receiving said reply, deleting the retrieved  
message from the memory device.

In rejecting claim 6, the Examiner admits that "Tobias fails to show: storing the retrieved voice message in a memory device from which the service subscriber can retrieve messages by telephone; deleting the retrieved message from said voice message system; and deleting the retrieved message from the memory device." (Office Action, p. 9.) To overcome these admitted deficiencies of the Tobias patent with respect to claim 6, the Examiner relies upon the Muller patent, asserting that "the Muller patent discloses these limitations (see columns 3, 6, and 8)." Applicants disagree that the Muller patent fills in the gaps in the Tobias patent. The Muller patent utilizes a Remote Answering Device to augment a network-based voice message system (Muller, Abstract). Generally, the Remote Answering Device does not store any voice message in a memory device, to say nothing of storing a retrieved voice message. For example, on col. 4, lines 43-47: "The user can press a simple 'play' button 23 to play back the messages. The Remote Answering Device 1 will automatically call up the user's voice mail box 12 and start playing the messages." Also, at col. 6, lines 26-28: "A power outage at home will not erase any messages, because the messages are stored at the Network Based Voice Mail System 6."

There is a brief reference at col. 6, lines 28-30 that states: "Alternatively, the messages could be stored in both places to ensure redundancy (or backup) for very

important messages.” However, this does not, nor is there any other reference in the Muller patent which does, store a retrieved voice message. Further, there is no indication in the Muller patent that a voice message stored in the Remote Answering Device can be retrieved by telephone, which is recited in claim 6. Still further, there is no description or suggestion in the Muller patent to delete the message (even though the message is not “retrieved” in the Muller patent as it is in claim 6) from the Remote Answering Device.

Furthermore, the Examiner admits that the “combination of Tobias and Muller doesn’t teach receiving a reply to said sending the digital audio file wherein the deleting limitations occur in response to receiving the reply.” (Office Action, p. 9.) To overcome the admitted deficiencies of the descriptions of the Tobias patent and the Muller patent with respect to claim 6, the Examiner relies on the Tverskoy application, asserting that “Tverskoy describes this limitation (paragraph 0033).” As noted above for claim 14, the Tverskoy application does not disclose or suggest the receipt of a “reply” E-mail; it simply refers to “instructions” sent to it utilizing E-mail.

As the cited references, either alone or in combination, do not teach or suggest all of the elements of claim 6, Applicants believe claim 6 to be patentable over the cited references. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 6.

#### IV. Claim 7 is Patentable

Claim 7 recites a method that includes:

- accessing a voice message system;
- retrieving, over a public telephone network, a voice message from the voice message system;
- generating a digital audio file representing said message;
- sending, using at least one Internet Protocol (IP) packet, the digital audio file representing said message to a service subscriber;
- receiving an E-mail message including a telephone number and an audio file; and
- initiating a telephone call using said telephone number.

In rejecting claim 8, the Examiner admits that the Tobias patent “does not teach receiving an E-mail message including an identifier and an audio file; and initiating a communication using the identifier.” (Office Action, p. 10.) To overcome the deficiencies of the Tobias patent with respect to claim 7, the Examiner relies on the Dorfman patent, asserting that “Dorfman clearly shows these features (see Figure 9).” (Office Action, p. 10.) Applicants disagree with this assertion. The Dorfman patent describes Figure 9 at col. 8 lines 11-31. This section explains that: “When the user chooses to reply to the voice mail message, the user will be presented with the option of replying via email or replying over the telephone.” If the user chooses the “telephone” option, the user’s telephone number is supplied to the voice server. If the user chooses to reply by E-mail, the user records a voice message which is forwarded to the voice server. The Dorfman patent does not, however, describe the situation wherein both a telephone number and a voice message are sent via E-mail, as recited in claim 7. Further, the telephone number referred to in the Dorfman patent is the subscriber’s number, whereas in claim 7 it is the number of the recipient of the attached voice message, further teaching away from the limitations of claim 7.

The Examiner goes on to state: “With further respect to claim 7, the combination of Tobias and Dorfman does not explicitly teach the identifier is a telephone number and the communication is a telephone call. On the other hand, Matthews teaches these limitations (see column 36).” First, there would be no reason to combine the Matthews patent with the other references for purposes of designing a system that would allow a recipient of a voice mail message to send an E-mail to a device with an included voice message and telephone number, as the Matthews patent doesn’t address these issues. It describes a voice response system which allows a user to control a voice mail system to send out voice messages. Further, in the Matthews patent, the system already knows the phone number of the message recipients, and therefore doesn’t receive E-mails with such numbers attached. In any event, the Matthews patent does not teach or suggest “receiving an E-mail message including a telephone number and an audio file.”

As the cited references, either alone or in combination, do not teach or suggest all of the elements of claim 7, Applicants believe claim 7 to be patentable over the cited references. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 7.

**V. Claims 9-13 are Patentable**

Claim 9 recites a method that includes:

- accessing a first voice message system;
- retrieving, over a public telephone network, a voice message from the first voice message system;
- generating a digital audio file representing said message;
- sending, using at least one Internet Protocol (IP) packet, the digital audio file representing said message to a service subscriber;
- storing a first prompt message;
- determining from subscriber input when the first prompt message should be loaded onto said first voice message system; and
- determining from said subscriber input when the first prompt message should be loaded onto a second voice message system.

In rejecting claim 9, the Examiner admits that "Tobias fails to disclose the claimed storing and determining methods." (Office Action, p. 11.) The Examiner further relies on the Wolf patent, asserting that "Wolf discloses these procedures (see Abstract)." Applicants must respectfully disagree that the Wolf patent overcomes the deficiencies of the Tobias patent with respect to claim 9. The Wolf patent relates to an interactive voice response system scripting process that is designed to operate with a compatible programmed voice message system. Conversely, the present invention as recited in claim 9 allows a user to load a prompt message onto multiple voice message systems. Therefore, not only does the Wolf patent not disclose the limitation of claim 9 of loading a prompt message on multiple voice message systems, but there would be no reason to consider doing so, as the Wolf system requires the remote device and the voice messaging system to be programmed to operate in conjunction with each other.

As the cited references, either alone or in combination, do not teach or suggest all of the elements of claim 9, Applicants believe claim 9 to be patentable over the cited references. Accordingly, Applicants respectfully request that the Examiner

withdraw the rejection of claim 9. Since claims 10-13 depend from claim 9, and therefore include all of the limitations of claim 9, these claims are patentable over the cited references for at least the same reasons as claim 9, and therefore Applicants respectfully request that the Examiner withdraw the rejections of claims 10-13 as well.

**VI. Claim 17 is Patentable**

Claim 17 recites a method that includes:

- receiving an E-mail message indicating that a voice message retrieved from said voice message system and forwarded to a service subscriber was reviewed;

- operating a subscriber computer system to automatically generate said E-mail message when a user of the subscriber computer system accesses an E-mail message which includes said retrieved message as an attached audio file;

- in response to receiving said automatically generated E-mail message, accessing said voice message system by placing a telephone call to said voice message system over a telephone network; and

- sending a control signal to said voice message system over said telephone network causing said retrieved voice message to be deleted from said voice message system.

The discussion above with respect to claim 14 applies as well to the Examiner's comments concerning the applicability of the Tobias patent and the Tverskoy application to similar elements of claim 17. In addition, the Examiner admits that neither the Tobias patent nor the Tverskoy application teach the "operating" limitation recited by claim 17, (Office Action, p. 12-13), but asserts that "the Nielsen patent reveals this limitation (see column 1)." (Office Action, p. 13.) Applicants must respectfully disagree. The Nielsen patent discloses a system for warning the sender of E-mail messages if the messages are not received. If there is an E-mail response to a sent E-mail, the system will recognize this fact, and notify the sender of the original E-mail if a response is not received. There is nothing in the Nielsen patent that discloses or suggests automatically generating any E-mail



messages, much less generating such an E-mail when the received E-mail includes a retrieved message as an attached audio file.

The Examiner further admits that “neither Tobias, Tverskoy nor Nielsen indicate the claimed accessing and causing steps. Nevertheless, Muller reveals these limitations (see column 6).” (Office Action, p. 13.) Applicants respectfully disagree that the Muller patent remedies this deficit, for the same reasons as articulated with respect to claim 14.

As the cited references, either alone or in combination, do not teach or suggest all of the elements of claim 17, Applicants believe claim 17 to be patentable over the cited references. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 17.

#### VII. Claim 8 is Patentable

Claim 8 recites a method that includes:

- accessing a voice message system;
- retrieving, over a public telephone network, a voice message from the voice message system;
- generating a digital audio file representing said message;
- sending, using at least one Internet Protocol (IP) packet, the digital audio file representing said message to a service subscriber;
- receiving an E-mail message including a telephone number and an audio file;
- initiating a telephone call using said telephone number;
- monitoring to detect a speech signal followed by a period of silence; and
- upon detecting said period of silence, playing the audio file.

The Examiner states on p. 14 of the Office Action: “Regarding claim 8, the combination of Tobias, Dorfman and Matthews teaches the claimed accessing, retrieving, generating, sending and initiating procedures as explained in the rejection of claim 7.” Applicants refer the Examiner to the discussion above concerning claim 7 as to the deficiencies of these references with respect to claim 7.

The Examiner admits that “the Tobias-Dorfman-Matthews grouping fails to teach the claimed monitoring and playing steps.” (Office Action, p. 14.) To

overcome these admitted deficiencies, the Examiner asserts that "Goldberg discloses this limitation (see column 6)." (Office Action, p. 14.) The Goldberg patent discloses a system and method for delivering automated pre-recorded messages to intended recipients. There is no teaching or suggestion of the utilization of voice message systems, to say nothing of the various limitations discussed above regarding Applicants' unique methods and systems. Therefore, there would be no reason to combine the Goldberg patent with any of the other references cited against claim 8. The Tobias patent discloses a device for forwarding voice mail messages via E-mail. There would be no need to consider a limitation of waiting for a speech signal followed by a period of silence, as this would have no meaning or use in the Tobias system. Similarly, the Dorfman patent discloses a voice mail system which sends voice messages via E-mail to its subscribers, and therefore would have no need to consider a limitation of waiting for a speech signal followed by a period of silence, as this would have no meaning or use in the Dorfman system. Finally, the Matthews patent discloses a voice message system which uses voice commands from users to manipulate various voice message functionality. There is no teaching of receiving E-mails, or of initiating calls based on such E-mails, so there would be no reason to consider the use of speech followed by silence to utilize such calls, as no such calls would be made.

As the cited references, either alone or in any proper combination, do not teach or suggest all of the elements of claim 8, Applicants believe claim 8 to be patentable over the cited references. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 8.

#### V. Conclusion

In view of the foregoing, Applicant respectfully submits that the pending claims are in condition for allowance. Reconsideration and allowance are respectfully requested. If there are any outstanding issues which need to be resolved to place the application in condition for allowance, the Examiner is invited to contact Applicant's undersigned representative by phone at the number indicated below to discuss such

issues. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to deposit account number 07-2347. With respect to this application, please charge any other necessary fees and credit any overpayment to that account.

Respectfully submitted,

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